## REMARKS

The present amendment is submitted in response to the Office Action dated April 27, 2004, which set a three-month period for response, making this amendment due by July 27, 2004.

Claims 1-18 and 30 are pending in this application.

In the Office Action, claims 1-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,803,616 to Persson et al in view of U.S. Patent No. 5,642,946 to Caillault et al.

The Applicant respectfully disagrees that the cited reference combination renders obvious the present invention as defined in claims 1-18.

Persson discloses a taper roller bearing, in which a great retainer ring 10 is attached to an outer ring 1 of the bearing and includes apertures 15 through which the grease that is inserted through grease holes 9 in the outer bearing ring 1 escapes toward the rollers 5. Persson's device does not include a second lubricant passage between an outer peripheral surface of an inner bearing part to an inner peripheral surface of the inner bearing part.

The Examiner combines Persson with Caillault in order to obtain the above feature, arguing that Caillault discloses such a lubricant passage through the inner bearing part. However, the seal 9 of Caillault is not a lubricant distributing element, as its purpose is to allow the passage of fluid through the bearing, while preventing the bearing lubricant from penetrating the regions via which the fluid passes through the bearing.

Therefore, the Applicant respectfully submits that the practitioner of ordinary skill in the art would not be lead to the present invention by combining the references as proposed. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ***In re Fritch***, 23 UPSQ 2d 1780, 1783-84 (Fed. Cir. 1992).

Indeed, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ***ACS Hosp. Sys., Inc. v. Montefiore Hosp.***, 221 USPQ 929, 932, 933 (Fed. Cir. 1984).

Also in this amendment, the Applicant has added new claim 30, which combines the features of claim 1 and claim 6. Again, the cited reference combination fails to disclose or suggest to the practitioner that "a first outflow path is formed between an outer surface of said lubricant distributing element which extends substantially orthogonal to an axial direction and a counter surface of said ring chamber which extends also substantially orthogonal to the axial direction".

The Applicant submits further that the remaining documents found by the Examiner in the search are even less relevant to the present invention. JP 5-164,127 ("JP '127") and U.S. Patent No. 3,885,842 to Furutsu show lubricant distributing elements roughly similar to that of Persson et al, that is, the lubricant distributing element is attached to an outer bearing part and includes only one outflow path for the lubricant.

U.S. Patent No. 6,428,212 to Tanaka is similar to Caillault, in that is discloses a passage 18 through the inner bearing part which is sealed off by seals 24 from the area of the rollers 3.

U.S. Patent No. 6,152,606 to Shirosaki et al discloses a floating ring 6, which is supposed to aid in the distribution of lubricant which can flow freely along and around the floating ring.

U.S. Patent No. 5,320,433 to Kimata et al discloses a lubricant reservoir attached to an inner race member. Lubricant can escape from the sealed reservoir into the space between the outer and the inner race through small channels between the contact faces of the lubricant reservoir members. Perforation holes 8 between the inner and outer surfaces of the inner race are not used as lubricant passages, but are only supposed to avoid a development of a negative pressure inside the reservoir.

U.S. Patent No. 5,253,733 to Miyachi and U.S. Patent No. 5,362,159 to Kufner et al are not relevant to the present invention.

Only U.S. Patent No. 6,227,713 to Neder et al has some relevance in that it does disclose two lubricant flow paths to the rollers 7 and through grooves 19 to the inner peripheral surface of the inner bearing part. However, the annular sealing ring 20 in this document is not a lubricant distributing element, but acts only as an overpressure valve for ventilating the bearing space 28 and compensating for pressure differentials.

For the reasons set forth above, the Applicant respectfully submits that claims 1-18 and 30 are patentable over the cited reference combination. The Applicant further requests withdrawal of the rejection under 35 U.S.C. 103 and reconsideration of the claims.

In light of the foregoing arguments in support of patentability, the Applicant respectfully submits that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

Michael J. Striker
Attorney for Applicant
Reg. No.: 27233
103 East Neck Road
Huntington, New York 11743
631-549-4700